

No. 2057.

IN THE
United States
Circuit Court of Appeals
FOR THE NINTH CIRCUIT

The Towne Steering Wheel Com-
pany, a corporation,
Complainant and Appellant,
vs.
Don Lee,
Defendant-Appellee.

REPLY BRIEF OF APPELLEE.

HENRY T. HAZARD,
Of HAZARD & STRAUSE,
Los Angeles, Cal.,
Solicitor for Appellee.

FILED

MAY 2 1916

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At the outset of our argument, it is distasteful to indulge in critical remarks involving an invasion of the rights of appellee, by counsel for appellant, but we think that, in view of the fact that we are, under the rules of this court, limited to but seven days within which to prepare, serve and file our reply brief, appellant should be made to understand that the same rule that prescribes seven days for us, prescribes that he shall serve and file his opening brief at least ten days before the date set for hearing, and not eight or nine days before.

This suit was brought by the appellant as complainant, in the United States Circuit Court for the Southern District of California, in the Southern Division, for infringement of United States letters patent No. 848,140, granted on March 26, 1907, to William F. Towne and Charles R. Sumner for a steering wheel for auto vehicles. We demurred to the bill of complaint on the ground that the patent involved is invalid upon its face, since the alleged invention covered thereby lacked patentable novelty and patentable invention, and after mature consideration by the learned judge below, our demurrer was sustained.

As a matter of law, there can be no doubt that letters patent should not have issued in this case, as the patent exhibits such a lack of patentable novelty upon its face as to warrant the court sustaining the demurrer interposed by appellee. The facts appearing upon the face of the patent come wholly within our common knowledge and are therefore matters of which the court may take judicial notice. These matters were carefully considered in the court below, and the ruling of the court on our demurrer *was not* the result of a passing glance, as intimated by counsel for appellant.

The most contended for by appellant is that through his overwhelming "inventive genius" he has successfully drawn from the storehouses of nature the new thought, that to get a firmer hand-hold on an object, circular in form, he can give it a serrated, indented, notched or corrugated surface, and the patent office has permitted such a thought to arise to the dignity of invention by issuing a patent therefor.

On page 17 of appellant's brief is designated two distinct results produced by HIS particular means for securing a firmer hold on a steering wheel, viz., the hand that is not grasping can rest upon the wheel and be supported while the wheel is passing through it, and to accomplish this result, appellant claims the distinction of having conceived the novel means of the application of a "smooth surface." We would feel somewhat embarrassed if called upon to indicate to this court just when it FIRST became known that a smooth surface would slip unimpeded through the ungripped human hand; but to the most casual observer it must occur, after a careful reading of the PATENT SPECIFICATION, that the *inventor* makes no such claim for his alleged invention as is given to it by his counsel. (Page 17 of appellant's brief.)

The undoubted intention of the patent was, as has been clearly set forth in the specification, is to "provide a steering wheel for automobiles with means for improving the grip or hold of the operator." (Page 1, line 9, of the specification.) Also, "The *especial object* of the invention is to provide means for firmly HOLDING THE WHEEL, when it tends to turn violently," etc. (Page 1, line 12, of patent specification.) To accomplish the above objects the patent office has issued an alleged patent, in which "the inventor" make three distinct claims as follows:

1. "A steering wheel having a rim with a smooth outer surface and an indented inner surface for the purposes set forth."
2. "A steering wheel having a rim with a smooth outer surface and an indented inner surface to form a continuous finger grip for turning the wheel."

3. "A steering wheel having a rim composed of inner and outer members, the outer member being supported in and by the inner member and having a SMOOTH OUTER SURFACE, and the inner member having an INDENTED INNER SURFACE."

This brings us to a consideration of the question, viz., does the patent here in controversy disclose a patentable invention, one in which the alleged improvement amounts to anything more than mere mechanical skill? Does the roughening of any portion of the surface of a circular steering wheel amount to patentable invention, as distinguished from mere mechanical skill, in view of the repeated practice from time immemorial of roughening hand-holds of all kinds for the purpose of securing a firmer grip on the object so roughened and to prevent the hand from slipping?

This case is of an exceedingly simple character, and such as should require no testimony to enlighten the court as to the nature of the invention. There is nothing obscure or difficult in the structure of the patented device requiring such testimony. In the light of a great number of decisions of the Supreme Court and the Circuit Court of Appeals, this case was properly decided by the court below upon demurrer. The Supreme Court of the United States early established the rule that cases of this character were PROPERLY decided upon demurrer. In point, we cite the case of *Richards v. Chase Elevator Co.*, 158 U. S. 299, in which it was held:

"While patent cases are usually disposed of upon bill, answer and proof, there is no objection, if the patent be invalid upon its face, to the point being raised on demurrer, and the case being determined upon the issue so formed. We have repeatedly held

that a patent may be declared invalid for want of patentable novelty, though no such defense be set up in the answer." (Citing *Dunbar v. Myers*, 94 U. S. 187; *Slawson v. Etc. Railway Company*, 107 U. S. 649; *Brown v. Piper*, 91 U. S. 27.)

Following this rule, the case of *Strom v. Weir*, 83 Fed. 170, 27 C. C. A. 502, held:

"That it was no longer open to question that where the case presented is clear and the court finds no difficulty in understanding the scope and character of the invention from the patent itself, when tested by the COMMON KNOWLEDGE pertaining to it, and thereupon discerns that the patent is not sustainable, the proper and expedient course is to dispose of the case on demurrer, and thus put an end to useless litigation."

And the same rule has been adhered to by courts in various cases, as, for instance, in the case of *Victor Talking Machine Company v. Etc. Mfg. Co.*, lately reported in 178 Fed. 455, in which the court said:

"The courts have recognized the duty imposed upon them where it is clear that the device of the patent in suit does LACK PATENTABLE INVENTION, to so declare and dispose of the case on demurrer, and thus put an end to long and useless and expensive litigation."

And our courts have followed this ruling to such an extent that although the question of validity of the patent in such a case has not been raised by the pleadings, the courts will always consider the question of whether the invention, which is the subject-matter in controversy, is patentable or not, as always an open one. We refer the court to the case of *Slawson v. Etc. Railway Co.*, 107 U. S. 649, and quote as follows:

“We think this patent was void on its face (because the improvement described therein was not patentable), and that the court might have stopped short at that time, without looking beyond it into the answer and testimony, * * * and well have ADJUDGED IN FAVOR OF THE DEFENDANT.”

And in our opinion it is not only a matter of justice and right that a case should be determined upon demurrer, but we respectfully submit it is the duty of the court to dismiss the case upon that ground and thus *avoid the time and expense* of needless litigation, which would necessarily follow if in every case the defendant should be put to his proofs.

Within the purview of the citations already presented it has been shown that there is no hesitancy on the part of the courts to dispose of a case upon demurrer on the ground that the same is lacking in patentable invention.

It remains then to be seen whether the structure as set forth by the claims of the patent is of a patentable nature. In this regard we have to consider whether the roughening or indenting of a hand wheel involves patentable novelty in view of *the well-known practice of roughening any hand-hold or other surface which is to be engaged by the hands of an operator*, and upon which the slipping of the hand should be prevented or otherwise.

On page 14 of appellant's brief he sets forth that claim 3 contains patentable subject-matter, in that it sets forth that a built-up construction as illustrated and described in the specification of the patent in suit is new, leaving for inference that the first two claims, which only cover an indented inner surface and a smooth exterior

surface of the wheel, are not new and patentable. *In order to support patentable novelty* for such a *built-up construction* as claim 3 sets forth, it was necessary to *include the subject-matter of the first two claims*, to-wit, a wheel having a smooth outer surface and an indented inner surface. If the indenting of the inner surface of a steering wheel is old and a matter of common knowledge, it certainly *would not support* a claim for a wheel made in *two* portions. It is perfectly obvious from the construction which illustrates claim 3 that to cast a circular rim having indentations in its inner periphery integral with the spokes and hub of the wheel, that it would be the most *common expedient*, that is to say, the most natural way of accomplishing such a construction, but evidently the patentee knew that metal would absorb heat and cold more readily than other materials and has substituted for an entire metal rim an outer ring of wood bolted or otherwise secured thereto. If by any chance such a built-up construction in itself was novel, then the inclusion of the *roughening means* would be utterly *unnecessary to support* the claim. The patent covers roughening means and does not embrace built-up construction.

It should be noted that nowhere in the patent itself is a claim setting forth a built-up construction without including the roughening means therein, and if the roughening means is not new, as set up in claim 3, *then the claim must fall*.

Referring to appellant's opening brief, at the top of page 16 the court will find appellant using as illustrative matter the case of a tennis racket, or a baseball bat, in a comparative sense with his claims under this patent for

an automobile steering wheel. They fail, however, to cite the court to the illustration of *an indented turning wheel of a valve* which is commonly used in connection with fluid service pipes for the purpose of controlling the flow of fluid therethrough, or the further illustration of the sword handles used at present by the United States and other governments, and which have been used by them from their inception, which are indented *on the inside of the handle* for the purpose of affording to the manipulator thereof a firmer hand-hold or grip. Likewise the watch stem, which latter shows the trend of human thought in this matter, and how common a mechanical expedient it is to indent or roughen a surface upon which it is desired to keep the hand or fingers from slipping.

In connection with this particular part of the alleged invention, we desire, at this time, to remind the court that appellant himself, in viewing the operation of the steering wheel of an automobile, is laboring under a total misconception of its real purpose. Appellant says, quoting from page 16, line 8, of his brief:

“If the steering wheel be provided with indentations which extend entirely around it, as has been the obvious thing heretofore, * * * the outer surface of the wheel being thereby corrugated or indented by the cord, will retard the motion of the wheel THROUGH ONE HAND WHILE THE OTHER HAND IS PULLING THE WHEEL AROUND, and thereby get the very purpose for which the corrugation is used.”

Hazarding the displeasure of the court, we feel it necessary to remind appellant of the fact that the operation of a steering wheel of an automobile is not ac-

complished in any such manner. Both hands of the operator move at the same time; *one hand does not pull the wheel while the other hand slips through, but both hands naturally follow and grip the wheel in the direction in which the wheel is being moved*, and we believe that this court will agree with us that the illustration of appellant, above quoted, is entirely without practicability, and of absolutely no value whatever in practice.

Reverting again to the claims of appellant, we suggest that they present a structure involving a rim with a smooth outer surface and an indented inner surface, indented in such a manner that the inner surface forms a continuous finger grip, and we submit that the only purpose for which the indenting of the inner surface of the steering wheel is to afford the operator a firmer hand-hold upon the wheel, the fingers fitting in the indentations or serrations on the inner surface, and the palm of the hand, being flat, requiring a smooth outer surface, for the comfort and convenience of the operator.

The libraries containing old books of reference illustrate our theory by exhibiting to us roughened or indented and serrated handles in common use thousands of years before the time of Christ. We have in mind swords in a reference book belonging to the public library of Los Angeles, entitled "The Book of the Sword," by Richard F. Burton, London, published in the year 1884, on page 80 of which figure 82 shows a sword or dagger with indented or serrated handle, brought from Thebes 3000 years B. C. Also on page 129 of the same work is another illustration, equally applicable to the case at bar, as illustrating the point contended for by appellee. We also refer the court to a book of similar character,

entitled "Spanish Arms and Armor," by Calvert, MCMVII, Figs. 169, 187, 207. Persian swords of the 16th century are shown with practically the same kind of indentations for receiving the fingers of the holders of such implements, and are identical with those shown and employed upon the hand wheels of the patent in controversy.

We cite also, for the court's consideration, "Appleton's Encyclopedia of Applied Mechanics," published by D. Appleton & Company. The supplementary volume, at page 883, Fig. No. 6, presents to us a cut or diagram illustrating the round, indented, circular handle of a valve, designated a relief valve, presenting the corrugated surface, placed upon the handle for the express purpose of giving a firmer hand-hold and preventing the hand from slipping during the process of operation.

All these matters involve articles of every day life and are undoubtedly within common knowledge, so that the court, in the light of a large number of decisions, cannot hesitate to take judicial notice thereof.

Thomas v. St. Louis, 149 Fed. 753, 79 C. C. A.;

Strom v. Weir, 83 Fed. 170, 27 C. C. A. 502;

Brown v. Piper, 91 U. S. 37;

Slawson v. Etc. Railway Co., 107 U. S. 649;

Richards v. Chase, 158 U. S. 299.

In the case of Slawson v. Etc. Railway Co., 107 U. S. 649, the court held:

"In Atlantic Works v. Brady, Mr. Justice Bradley said: 'The design of the patent laws is to reward those who make some *substantial discovery* or invention which adds to our knowledge and makes a step in advance in the useful arts, BUT IT

WAS NEVER THE OBJECT OF THESE LAWS TO GRANT A MONOPOLY FOR EVERY TRIFLING DEVICE, EVERY SHADOW OF AN IDEA WHICH WOULD NATURALLY AND SPONTANEOUSLY OCCUR TO ANY SKILLED MECHANIC OR OPERATOR IN THE ORDINARY PROGRESS OF MANUFACTURE.' The same authorities apply with equal force to the patent for lighting the interior of the fare box at night by using the headlight of the car for that purpose. The elements of the contrivance, viz., the fare box, the headlight and the reflector, are all old. What is COVERED BY THE PATENT is simply the making of an aperture in the top of the fare box and turning the rays of the head lamp through it into the box by means of a reflector. In other words, it is the turning of the rays of the light to the spot where they are wanted by means of a reflector, and taking away an obstruction to their passage. The facts of GENERAL knowledge of which we take JUDICIAL notice, teach us that devices similar to this are as old as the use of reflectors. THE NEW APPLICATION OF THEM DOES NOT INVOLVE INVENTION. We are of the opinion that there was nothing patentable in the contrivance described in the patent."

And the decree of the Circuit Court was thereupon affirmed.

In the case of Victor Talking Machine Company v. Etc. Mfg. Co., reported in 178 Fed. 455, it was held:

"The means of securing the parts when thus put together by a simple pin or lug on the inside of the horn part to engage in the cam-like slot in the conveyor part, and the further drawing together of the parts by turning the pin in the slot, ARE MEANS SO OBVIOUS TO ANY MECHANIC THAT NO INVENTION CAN POSSIBLY BE INVOLVED THEREIN. * * * These disadvantages are said by counsel in his argument to be obvious and evident to the court. If so, as also said by the court below, they did not require expert or other testimony to point them out, being obvious and self-evident, the remedy em-

ployed of cutting the horn in two sections WAS EQUALLY OBVIOUS AND SELF-EVIDENT, and to claim a patent monopoly therefor IS A MISUSE OF THE PATENT LAWS, WHICH ARE TO FOSTER INVENTION ALONE.”

This court will observe in the light of the foregoing decisions, applying the rulings there laid down to the facts of this case, that the use of roughened, indented, serrated or corrugated surfaces are for preventing the slipping of hands upon implements or articles and insuring a safer hand-hold, and are such facts as come within our general knowledge, as is indicated, and such as the courts take judicial notice of. Here the elements of the device in controversy, to-wit, the hand wheel, including the rim, made in either one or two parts, that is immaterial, having a roughened or indented finger-engaging surface, either inside or out, are old elements, and the mere placing of such indentations at a position upon the hand-hold, *where they will be best engaged by the fingers of the driver of an automobile*, cannot, under any force of circumstances, possibly constitute an invention.

In the case at bar it would not, it seems to us, require more than the most ordinary mechanical skill to have determined that if the hands, in grasping the steering wheel of an automobile, had a tendency to slip, such slipping could be prevented by INDENTING OR ROUGHENING THE INNER SURFACE OF THE WHEEL, where the fingers of the hand would be found to clasp it; and this would lead to the further “discovery” that a smooth outer surface of the wheel would be easier upon the palm of the hand than to be required to grasp firmly with

the palm a roughened or corrugated surface; and to claim a *monopoly* for the use of this old and well-known expedient would be a gross misuse of the patent laws and an unwarranted violation of the rights of others.

In conclusion, we direct the attention of the court to the fact that one of the grounds of demurrer was taken with a view to the fact that the claims show and admit, by their own express limitation, that the broad principle of roughening the surface of a hand wheel was neither novel nor new. The claims include a specification OF A SMOOTH OUTER SURFACE, limiting the indentations or roughness to the INNER SURFACE ONLY. The direct inference is that to roughen surfaces of wheels somewhere is not new, and following this inference it must be evident that the mere shifting of the indentations to the portion of the wheel which the fingers are most likely to engage would certainly not require anything more than ordinary mechanical skill. We submit that in any view of the case the claims do not possess features, either novel or new, or present anything but the most ordinary and common expedient of the ordinary mechanic, and all contended for by appellant is properly designated as a new application of old facts, *all of general knowledge*, and do not in any sense of the word call forth anything further than ordinary mechanical skill, which, under no conditions, can be characterized as arising to the dignity of invention, or calling for inventive ingenuity.

HENRY T. HAZARD,

Of HAZARD & STRAUSE,

Solicitor for Appellee.

